

REMARKS

Claims 1-23 are pending in the Application. By this Amendment, Applicant has amended claims 1, 2, 12, 15, and 20. The amendment is supported by the application at, e.g., Figures 38-39 and the corresponding text.

Rejections under Section 102.

According to the Office Action claims 1, 10, 13, 19, and 20 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,068,628 to Fanton et al (hereafter referred to as "Fanton"). The Office action also indicates that claims 1-9, 11, 12, 15, and 16-18 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,381,007 to Doss (hereafter referred to as "Doss").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 *citing* Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

Regarding independent Claim 1, it recites a claim limitation that is not found in any of the cited references. In particular, amended claim 1 now recites, amongst other things, that the return electrode has an exposed surface area that is substantially larger than that of the active electrode so as to have no tissue effect. This is quite different than both of the bi-active devices cited against Claim 1. The bipolar configurations shown in Figures 8-9 of Fanton show electrodes having similar shape and size. There does not appear to be any size different. Doss also discloses two electrodes of similar exposed surface area. The electrodes act as biactive electrodes. Each electrode has a tissue effect. In contrast, Claim 1 recites a return electrode that has a substantially larger exposed surface area than the active electrode. This is not shown in the cited references.

Regarding independent Claim 12, it recites an annular support that includes two ports connected by a void. Each of the ports are on a surface of the support at the distal end of the device. This is shown, e.g., in figures 38-39. In contrast, the cited references do not show an annular support having a void connecting two ports. Doss provides an elongate tube and Fanton appears to provide a solid support.

Regarding independent Claim 20, it recites an annular support. Fanton does not appear to recite a ring shaped support. Fanton shows a curved circular body having electrodes disposed therein. Thus Fanton does not disclose an annular support.

Based on the foregoing, Applicant requests reconsideration and withdrawal of the rejections of the claims based on Section 102.

Rejections based on Section 103.

The Office Action rejected Claim 14 under 35 U.S.C. §103(a) as being unpatentable over Fanton in view of Doss. The Office Action also rejected Claims 21-23 under 35 U.S.C. §103(a) as being unpatentable over Fanton.

As indicated above Fanton and Doss do not teach all claim limitations recited in the independent claims. A proper *prima facie* case of obviousness under Section 103 requires, amongst other things, that the reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2142. In this instance, none of the cited references teach or suggest the claim limitations discussed above in connection with claims 1, 12, and 20.

Based on the foregoing, Applicant requests reconsideration and withdrawal of the rejections of the claims based on Section 103.

Applicant has made a sincere effort to respond to each of the outstanding issues raised in the Office Action. If the Examiner believes a telephone conference would facilitate prosecution of this application, please telephone the undersigned at the below listed number.

Respectfully submitted,



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